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10/597,782	08/08/2006	Roger Bassett	35210-66480	6300

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Levenfeld Pearlstein, LLC
Intellectual Property Department
2 North LaSalle
Suite 1300
Chicago, IL 60602

EXAMINER	
JOHNSON, AMY COHEN	

ART UNIT	PAPER NUMBER
2841	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MJWDOCKET@LPLEGAL.COM
MEFDOCKET@LPLEGAL.COM
RAMDOCKET@LPLEGAL.COM

Office Action Summary	Application No.	Applicant(s)	
	10/597,782	BASSETT, ROGER	
	Examiner	Art Unit	
	Amy Cohen Johnson	2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-70* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-58 and 63-70* is/are rejected.

7)☒ Claim(s) *59-62* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 August 2006* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/08/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one LED, scale of increasing or decreasing bar must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because reference number 33 is not associated with any feature in the drawings, i.e., reference number 33 does not have an arrow or line connecting it to

a feature in the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 36-70 are objected to because of the following informalities:

Claims 36-70 lack status identifiers "new." Applicant is reminded to include status identifiers in all subsequent listings of claims in order to avoid any amendments being held as non-compliant.

Claim 53, lines 1-2 the power supply means has already been claimed in claim 35. It is unclear if the power supply means of claim 53 is the same as the power supply means of claim 36.

Claim 65, line 2 the means electronically engageable with the body already has been claimed to include "power supply means" in claim 36.

Appropriate correction is required.

4. Claims 69 and 70 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 69 and 70 recite only intended use of the device, i.e. "for a boring bar" and "for a reaming tool," and do not further limit the structure of the system or the body of claim 36. Therefore, claims 69 and 70 are considered to be improper dependent claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 36-42, 47, 64-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Steen et al. (U. S. Patent No. 5,447,517).

Steen et al. teaches a cutting tool adjustment system (10, 20) comprising a body (24) for adjustably holding a cutting tool, adjustment means (74, 78, 80) mechanically releasably engageable with the body for positionally adjusting a cutting edge (28) of the cutting tool (Fig. 11, Col 6, lines 42-61), and means electronically engageable with the body and including power supply means for at least powering means for providing information (20, 38, 40) as to adjustment made, in use, to said cutting edge position by said adjustment means (Figs. 1, 2, Col 4, lines 27-54, Col 6, lines 42-61, wherein the means electronically releasably engageable with the body are the wires connecting the body 18 at sensor 26 to the display means 20, the wires are not numbered but contain connections to the display means which are releasable, the display means would include a power supply since the display means are connected to sensor 26 and interpret the signals and display the signals on the screens 28 and 40).

Steen et al. teaches the system wherein the means providing information as to the adjustment made to the cutting tool edge position is a visual display (38, 40); wherein the visual display is an electronic display (38, 40); wherein the visual display is part of the means electronically releasably engageable with the body (Figs. 1 and 2, Col 4, lines 27-54); wherein the visual display shows the adjustment as the adjustment means is operated (Figs. 1 and 2, Col 4, lines 27-54, Col 6, lines 42-61, since 26 senses the amount of movement of the blade and is connected to the visual display, the visual display will show the adjustment as the adjustment means is operated); wherein the visual display shows a pre-programmed amount of adjustment (Col 6, lines 42-61, wherein when the electric motor is operated by a computer which automatically moves and sets the blade, the amount of adjustment is pre-programmed into the computer); wherein the adjustment means is motor driven (80) and the pre-programmed amount

of adjustment is effected automatically upon engagement of the electronically engageable means with the body (Col 6, lines 42-61, since the adjustment is automatically made by the computer, the pre-programmed amount of adjustment is considered to be effected automatically upon engagement, further, a computer can be programmed so that the pre-programmed amount of adjustment is effected automatically upon engagement of the electronically engageable means).

Steen et al. teaches the system wherein the visual display is part of a display module (34, 36), spaced from the adjustment means and the means engageable with the body (Figs. 1 and 2), and incorporating a receiver for a signal transmitted from the body or the means engageable therewith (Figs. 1 and 2, Col 4, lines 27-54, Col 8, lines 22-47).

Steen et al. teaches the system wherein the adjustment means (74, 78, 80) is separate from the means electronically engageable with the body and is not fitted thereto, in use (Figs. 1, 2, 11); wherein the means electronically engageable with the body contains power supply means and electrical contact means for engagement with electrical contact means of the body, as well as visual display means (Figs. 1 and 2, Col 4, lines 27-54); wherein the body has said electrical contact means (at sensor 26) spaced from internal adjustment screw means (teeth on 32) for receiving an interengaging adjusting part (76) of the adjustment means (Col 6, lines 42-51).

Steen et al. teaches the system in which the body (24) is a cartridge (Fig. 2, the body can be considered a cartridge since there are no structural limitations claimed which define the term "cartridge"); wherein the body is a bush unit (Fig. 2, the body can be considered a bush unit since there are no structural limitations claimed which define the term "bush unit").

Regarding claims 69 and 70, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus satisfying the claimed structural limitations. ***Ex parte Masham***, 2 USPQ2d 1647 (1987). See MPEP 2106 and 2111.04. In this case the intended use is considered to be "for a boring bar" and "for a reaming tool" since these are recitations with respect to the manner in which the body is intended to be employed and do not structurally differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations of a body. It is noted that there are no structural limitations claimed for the term cartridge and how it would be used for a boring bar or for a reaming tool, therefore, these limitations are considered to be intended use of the apparatus.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 44, 46, 48, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steen et al.

Steen et al. discloses the system as described above in paragraph 6.

Steen et al. does not disclose the system specifically wherein the visual display is an LCD; wherein the display is provided with a scale, adjustment of the cutting edge position being shown by way of an increasing or decreasing bar.

With respect to claims 44, 48: Steen et al. discloses a cutting tool adjustment system comprising an electronic display. The use of the particular type of electronic display claimed by applicant, i.e., an LCD, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the data can be visually displayed on an electronic display as already suggested by Steen et al., 2) the electronic visual display claimed by Applicant and the electronic visual display used by Steen et al. are well known alternate types of electronic displays which will perform the same function, if one is replaced with the other, of displaying data visually to a user, and 3) the use of the particular type of electronic display by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of electronic displays that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to electronically display data to a user as already suggested by Steen et al. See MPEP 2144.06 and MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the electronic display be an LCD since LCD screens are commonly used electronic displays which are able to be easily manipulated to clearly display data to a user.

With respect to claim 46: Steen et al. discloses an electronic display providing data. The use of the particular type of display claimed by applicant, i.e., providing a scale with an increasing or decreasing bar, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art,

will be obtained as long as the data is visually displayed to a user, as already suggested by Steen et al., 2) the type of display claimed by Applicant and the type of display used by Steen et al. are well known alternate types of visually providing data which will perform the same function, if one is replaced with the other, of providing a user with a visual display of data, and 3) the use of the particular type of display by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of displays that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to provide a visual display of data as already suggested by Steen et al. See MPEP 2144.06 and MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data displayed as a scale with an increasing or decreasing bar in order to provide a clear visual display to a user of the data and so that a user could quickly determine if a measurement was increasing or decreasing without needing to interpret numerical information.

With respect to claim 49: Steen et al. discloses a display module with a power supply. The use of the particular type of display module claimed by applicant, i.e., hand-held, battery-powered device, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the data is displayed on a powered display device as already suggested by Steen et al., 2) the display module claimed by Applicant and the display module used by Steen et al. are well known alternate types of display modules which will perform the same function, if one is replaced with the other, of displaying data to a user, and 3) the use of the particular type of display module by Applicant is considered to be nothing more than the use of one of numerous

and well known alternate types of display modules that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to display data to a user, as already suggested by Steen et al. See MPEP 2144.06 and MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the display module be a hand-held, battery-powered device in order to provide a display module which is easily moved by a user so that the display module is in a convenient location for the user as the user operates the cutting tool adjustment system.

9. Claims 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steen et al. in view of Struble (U. S. Patent No. 5,657,550).

Steen et al. discloses the system as described above in paragraph 6; wherein the adjustment means is manually operated (Col 6, lines 42-53, wherein when the motor 80 is not connected to a computer, a user would manually operate motor 80).

Steen et al. does not disclose the system wherein at least one LED turns on or off to indicate when said pre-programmed amount of adjustment has been effected; wherein the means for providing information as to the adjustment made to the cutting edge position is a simulated voice output.

Struble discloses a device wherein at least one LED (174) turns on or off to indicate when said pre-programmed amount has been measured (Col 10, lines 40-54, Col 18, lines 1-11); wherein the means for providing information as to the adjustment made to the cutting edge position is a simulated voice output (Col 30, lines 44-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least one LED and/or a simulated voice output in the system of Steen et

al., as taught by Struble, so that a user would have a clear indication of a pre-programmed amount without the need to interpret numerical data.

10. Claims 50-58, 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steen et al. in view of Mastel et al. (U. S. Patent No. 4,662,075).

Steen et al. discloses the system as described above in paragraphs 6 and 8; wherein the adjuster tool is engaged with the body (Figs. 1, 2, 11), operation of said adjustment means turns an adjusting screw (32) controlling the position of the cutting edge (Col 4, lines 27-35, Col 6, lines 42-61, Col 7, lines 34-50); wherein when the adjuster tool is engaged with the body, there is at least one electrical contact therebetween (Figs. 1 and 2, Col 4, lines 36-54); wherein the body contains electronic circuitry (at 26) which generates a signal voltage dependent upon the amount of adjustment of the cutting tool edge (Col 4, lines 36-54); wherein the electronic circuitry regulates and applies an output from an electronic position sensor monitoring the position of said cutting tool edge (Col 4, lines 36-54, Col 8, lines 6-47).

Steen et al. does not disclose the system wherein the adjustment means is fitted to the means electronically engageable with the body to define an adjuster tool.

Mastel et al. discloses a cutting tool adjustment system wherein the adjustment means (74) is fitted to the electronic means (64) to define an adjuster tool (Figs. 1-4, 6, Col 4, line 54-Col 5, line 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system of Steen et al. be combined to a fitted adjuster tool, as taught by Mastel et al., so that the display device and the adjustment means would form a single tool unit, thereby allowing the display to be positioned close to the adjustment means so that a user would

be able to see the display in close proximity to the adjustment means, creating a more compact system.

With respect to claim 54: Steen et al. and Mastel et al. disclose the system with a power supply. The use of the particular type of power supply claimed by applicant, i.e., rechargeable battery, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the data is displayed on a powered display device as already suggested by Steen et al. and Mastel et al., 2) the power supply claimed by Applicant and the power supply used by Steen et al. and Mastel et al. are well known alternate types of power supplies which will perform the same function, if one is replaced with the other, of powering a display device, and 3) the use of the particular type of power supply by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of power supplies that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to power a display device, as already suggested by Steen et al. and Mastel et al. See MPEP 2144.06 and MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the power supply be a rechargeable battery in order to provide a power supply for the display module which is easily moved by a user so that the display module is in a convenient location for the user as the user operates the cutting tool adjustment system.

With respect to claim 57: Steen et al. and Mastel et al. disclose a system wherein there is a relationship between the amount of adjustment of the cutting tool edge and the signal voltage.

The use of the particular type of relationship claimed by applicant, i.e., non-linear, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the amount of adjustment of the cutting tool edge is able to be determined, as already suggested by Steen et al. and Mastel et al., 2) the relationship claimed by Applicant and the relationship used by Steen et al. and Mastel et al. are well known alternate types of relationships which will perform the same function, if one is replaced with the other, of indicating the amount of adjustment of the cutting tool edge, and 3) the use of the particular type of relationship by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of relationships that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to indicate the amount of adjustment of the cutting tool edge as already suggested by Steen et al. and Mastel et al. See MPEP 2144.06 and MPEP 2144.07. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the relationship be non-linear since linear and non-linear relationships are only a product of the specific circuitry used in the device and can be replaced one with the other as needed by the specifics of the device.

With respect to claim 63: Steen et al. and Mastel et al. discloses a system wherein the adjustment means is fitted to the means electronically engageable with the body to define an adjuster tool which has a means for controlling the adjustment of the cutting tool edge (Col 6, lines 42-61). The use of the particular type of control means claimed by applicant, i.e., a rocker switch for 'up/down' adjustment, absent any criticality, is considered to be nothing more than a

choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as adjustment is controlled, as already suggested by Steen et al. and Mastel et al., 2) the control means claimed by Applicant and the control means used by Steen et al. and Mastel et al. are well known alternate types of control means which will perform the same function, if one is replaced with the other, of controlling adjustment of the cutting tool edge, and 3) the use of the particular type of control means by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of control means that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to control the adjustment of the cutting tool edge as already suggested by Steen et al. and Mastel et al. See MPEP 2144.06 and MPEP 2144.07. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the control means be a rocker switch so that a user would be able to easily manipulate operation of the device and control the means for adjusting the cutting tool edge.

Allowable Subject Matter

11. Claims 59-62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

12. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or suggest a cutting tool adjustment system wherein the power from the adjuster tool is passed via one electrical input contact to the electronic circuitry on the body, whilst said output signal voltage is made available at a second electrical contact between the body and the adjuster tool in combination with the remaining limitations of the claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Davis (US PGPUB 2004/0040169), Tadaki (US PGPUB 2001/0020336), Marquart (U. S. Patent No. 7,469,484), Sluder (U. S. Patent No. 6,978,552), Bassett (U. S. Patent No. 6,422,012), and Gyoury et al. (U. S. Patent No. 5,036,596).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Cohen Johnson whose telephone number is (571)272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinhee J. Lee can be reached on (571) 272-1977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy Cohen Johnson
/Amy Cohen Johnson/
Primary Examiner, Art Unit 2841

ACJ
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